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PATENT
Atty. Dkt. No 069974-0152

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PTA of U.S. Pat. No. 7,186,495 issued 03/06/2007:

Applicant: Katsumi Maeda
Title: (METH)ACRYLATE DERIVATIVE, POLYMER AND
PHOTORESIST COMPOSITION HAVING LACTONE
STRUCTURE, AND METHOD FOR FORMING PATTERN
BY USING IT
Appl. No.: 09/750,116
Filing Date: 12/29/2000
Examiner: R. Ashton
Art Unit: 1752
Confirmation No. 6329

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED IN THE PATENT UNDER 37 C.F.R. § 1.705(d)

MS Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 1.705(d), Patentee requests reconsideration of patent term adjustment. Patentee received the Decision Regarding PTA, mailed 01-23-2007 in application No. 09/750,116, and thanks the Office for the PTA corrections made in the Decision. Since the Decision, the '116 application has issued as U.S. Patent number 7,186,495, having a final PTA adjustment of 499 days listed on its face. Patentee respectfully requests the PTO to change the Determination of Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b) and submits that the PTA should be 1,411 days, instead of 499 days, due to the PTO's delay, less Patentee's delay.

The facts begin on the next page of this Request.

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I. Facts

A. General Information

1. U.S. Application no. 09/750,116 was filed under 35 U.S.C. § 111(a) on 12-29-2000.
2. Under 35 U.S.C. § 154(b), the '116 application is eligible for Adjustments of Patent Term (PTA).
3. The '116 application issued as U.S. Patent No. 7,186,495 on 03-06-2007.
4. This request is being filed within the two-month window allowed under 37 C.F.R. § 1.705(d) and is therefore a timely filed request.
5. Under 37 C.F.R. § 1.705(b)(1), the fee set forth in 37 C.F.R. § 1.18(e) (\$200) is being filed with this request.
6. Under 37 C.F.R. § 1.705(b)(1)(ii), relevant dates, with emphasis (bold,¹ dashes,² numbers and subsections) on important items, are as follows:

Table 1. Relevant Dates

Date	Event	Days since actual filing date	Rule 702(a)(x) ³	Rule 702(b)	Rule 702(c)	Rule 704(y) ⁴
12-29-2000	Application Filed under 35 U.S.C. § 111(a)	0				
11-29-2001	Mail Non-Final Rejection under 35 U.S.C. § 132	335				
02-27-2002	Reply under § 1.111 to a Non-Final Action	425				

¹ Identifies a particular paper.

² Identifies the start of a period.

³ When (x) is (2), e.g., the Rule is 702(a)(2).

⁴ When (y) is (b), e.g., the Rule is 704(b).

06-27-2002	four months after the date a reply under § 1.111 was filed	545	--			
12-04-2002	Mail Non-Final Rejection under 35 U.S.C. 132	705	160 (x) = (2)			
03-04-2003	three months after the date of mailing of the Office Action	795				--
03-31-2003	Reply after Non-Final Action with Request for Extension of Time	822				(-27) (y) = (b)
06-20-2003	Mail Letter of Suspension	903				
07-31-2003	four months after the date a reply under § 1.111 was filed	944	--			
12-29-2003	three years after the actual filing date	1095		--		
04-01-2005	Declaration of Interference	1554			--	
07-15-2005	Mail Interference Decision - Favorable	1659				
09-16-2005	Interference Termination (date on which no appeal or other review has been or can be taken or had from the interference decision)	1722			168	

11-15-2005	four months after the date of a final decision by the Board	1782	- - -			
07-10-2006	Mail Notice of Allowance	2019	273 (x) = (3) 1075 (x) = (2)			
08-08-2006	Amendment after Notice of Allowance	2048				- -
09-12-2006	Mail Response to 312 Amendment (PTO-271)	2083				(-36) (y) = (c) (10)
10-10-2006	Issue Fee Payment Received	2111				
09-26-2006	Petition Entered	2097				
01-23-2007	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance	2216				
02-10-2007	four months after the date the issue fee was paid	2234	- -			
03-06-2007	Patent Issue Date	2258	24 (x) = (4)			
		Totals	1259	995	168	(-63)

7. Under 37 C.F.R. § 1.705(b)(iii), the '495 patent is not subject to a terminal disclaimer.

8. 37 C.F.R. § 1.705(b)(iv)(A) statement: Patentee submits that the Reply to the Office Action, filed on 03-31-2003, was filed 27 days beyond the three-month period for response set out in 37 C.F.R. § 1.704(b). Patentee submits that an amendment after allowance actually received by the PTO 08-08-2006 resulted in 36 days of delay, because the PTO responded to

the effective Rule 312 amendment on 09-12-2006. Summing 27 days and 36 days, the admitted delay is (-63) days due to Patentee's delay.

B. Decision on the Request for Reconsideration of the Determination of PTA Under Rule 705(b)

9. The Notice of Allowance and Fees due dated 07-10-2006 was accompanied by a Determination of Patent Term Adjustment (PTA) indicating 949 days of adjustment.

10. Patentee requested reconsideration of the Determination of PTA urging the PTO to award Patentee 1208 days of adjustment. Request filed 09-26-2006, p. 1. The present request for reconsideration asks for 1411 days of adjustment. This difference between the present request and the previous request (1411 days-1208 days), in large degree, is due to the inclusion of the Rule 702(b) period, which was not and could not be considered in the first request for reconsideration.

11. The Decision on the Request did not consider PTO delay under Rules 702(a)(4) (issuing a patent within four months of paying the issue fee) and 702(b) (issuing a patent within three years of the actual filing date). Decision, p. 2.

12. The Decision on the Request did not consider Applicant's (now Patentee's) delay under Rule 704(c)(10) (regarding amendments after notice of allowance). Decision, p. 2.

13. The PTO granted the Request but adjusted the PTA to 511 days, because "The Office notes further that the 1075 day positive period [between the Reply filed 03-31-2003 and the notice of allowance dated 07-10-2003] is also in error. The Office notes that the Office responded to applicant's reply of 3/31/03 on June 20, 2003 by suspending the application pending interference review." Decision, p. 1, last paragraph.

14. The Decision itemized the PTA as follows:

A. 0 days of PTA under Rule 702(a)(1).

B. 160 days of PTA under Rule 702(a)(2): this period was determined by the period of delay between the reply filed 02-27-2002 and the PTO's Office action dated 12-02-2002.

C. 273 days of PTA under Rule 702(a)(3): this period was determined by the period of delay between the Board Decision dated 07-15-2005 and the Notice of Allowance dated 07-10-2006.

D. Explicitly did not determine the period under Rule 702(a)(4).

E. Explicitly did not determine the period under Rule 702(b).

F. 105 days of PTA under Rule 702(c): this period was determined by the period of delay during the interference declared 04-01-2005 and decided 07-15-2005.

G. (-27 days) of PTA under Rule 704(b): this period was determined by the period of delay between the Office action dated 12-04-2002 and the reply filed 03-31-2003.

H. Explicitly did not determine period of delay under Rule 704(c)(10).

I. 511 days of total PTA: this was determined by summing the periods A+B+C+F+G (i.e., $160+273+105-27=511$ days).

C. PTA on the face of U.S. Patent No. 7,186,495 issued 03-06-2007

15. U.S. Patent No. 7,186,495 issued 03-06-2007 and indicated 499 days of PTA.

16. Studying the data available from PAIR and the record, the undersigned believes that the data used to reach the 499 days of PTA is calculated as follows:

A. 0 days of PTA under Rule 702(a)(1).

B. 160 days of PTA under Rule 702(a)(2): this period was determined by the period of delay between the reply filed 02-27-2002 and the PTO's Office action dated 12-02-2002.

C. 273 days of PTA under Rule 702(a)(3): this period was determined by the period of delay between the Board Decision dated 07-15-2005 and the Notice of Allowance dated 07-10-2006.

D. 24 days of PTA under Rule 702(a)(4): this period was determined by the period of delay between paying the issue fee on 10-10-2006 and issuing the patent on 03-06-2007.

E. The PTO did not determine the period under Rule 702(b).

F. 105 days of PTA under Rule 702(c): this period was determined by the period of delay during the interference declared 04-01-2005 and decided 07-15-2005.

G. (-27 days) of PTA under Rule 704(b): This period was determined by the period of delay between the Office action dated 12-04-2002 and the reply filed 03-31-2003.

H. (-36 days) of PTA under Rule 704(c)(10): this period was determined by the period of delay between the Rule 312 amendment that was received by the PTO 08-08-2006 and the entry of that Rule 312 amendment on 09-12-2006.

I. 499 days of total PTA: this was determined by summing the periods A+B+C+D+F+G+H (i.e., $160+273+24+105-27-36=499$ days).

II. Bases for Reconsideration of PTA under Rule 705(d)

17. There are three bases for reconsideration, namely, 37 C.F.R. § 1.702(c), 37 C.F.R. § 1.702(a)(2), and 37 C.F.R. § 1.702(b).

A. First Basis for Reconsideration of items relevant to PTO under 37 C.F.R. § 1.702(c)

18. The 105 day period under Rule 702(c) is too small. The actual period should be 168 days.

19. An interference was declared 04-01-2005.

20. The Board entered a decision in the interference on 07-15-2005. This decision did not terminate the interference.

21. The interference “terminated,” as that term is used in Rule 703(c)(1), 09-16-2005.

22. Rule 703(c)(1) reads, with emphasis on relevant language, as follows:

(c) The period of adjustment under § 1.702(c) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and **ending on the date that the interference was terminated** with respect to the application;

23. Terminated is defined in BdR 205(a), which reads, with emphasis on the relevant language, as follows:

§ 41.205 Settlement agreements.

(a) **** After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had....

24. Under 35 U.S.C. §§ 141-42, 146, the day in which **no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had** is prescribed by the Director but in no case can be less than 60 days after that date.

25. Rule 304(a) sets the period at two months:

§ 1.304 Time for appeal or civil action.

(a)(1)The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is **two months** from the date of the decision of the Board of Patent Appeals and Interferences. ****

26. Two months after the Board Decision of 07-15-2005 is 09-15-2005. In other words, for purposes of these rules, an appeal could have been filed on September 15th. As a result, the first possible date upon which **no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had** is the following day, 09-16-2005.

27. Therefore, the interference terminated 09-16-2005 (not 07-15-2005).

28. If the Board grants just this basis for reconsideration, then the total patent term could be calculated as follows:

A. 0 days of PTA under Rule 702(a)(1).

B. 160 days of PTA under Rule 702(a)(2): this period was determined by the period of delay between the reply filed 02-27-2002 and the PTO's Office action dated 12-02-2002.

C. 273 days of PTA under Rule 702(a)(3): this period was determined by the period of delay between the Board Decision dated 07-15-2005 and the Notice of Allowance dated 07-10-2006.

D. 24 days of PTA under Rule 702(a)(4): this period was determined by the period of delay between paying the issue fee on 10-10-2006 and issuing the patent on 03-06-2007.

E. The PTO did not determine the period under Rule 702(b).

F. 168 days of PTA under Rule 702(c): this period was determined by the period of delay during the interference declared 04-01-2005 and terminated 09-16-2005.

G. (-27 days) of PTA under Rule 704(b): this period was determined by the period of delay between the Office action dated 12-04-2002 and the reply filed 03-31-2003.

H. (-36 days) of PTA under Rule 704(c)(10): this period was determined by the period of delay between the Rule 312 amendment that was received by the PTO 08-08-2006 and the entry of that Rule 312 amendment on 09-12-2006.

I. 562 days of total PTA: this was determined by summing the periods A+B+C+D+F+G+H (i.e., $160+273+24+168-27-36=562$ days).

29. This issue could not have been raised in the first request for reconsideration under Rule 704(b), because this period overlapped with the 1075 day period under Rule 702(a)(2) and Patentee could not determine how the PTO itemized this period. *Cf.* 37 C.F.R. § 1.705(d).

B. Second Basis for Reconsideration of items Relevant to PTA under 37 C.F.R. § 1.702(a)(2)

30. The PTO's period of delay between the Reply dated 02-27-2002 and the Rejection dated 12-04-2004 is 160 days and is correct.

31. The total period under 37 C.F.R. § 1.702(a)(2) is too small, because the PTO's delay between the Reply dated 03-31-2003 and the notice of allowance dated 07-10-2006 is 1,075 days, which are additional adjustments that are due under 37 C.F.R. § 1.702(a)(2). A total of 1259 days of PTA is due, i.e., $(160+1075)$ days = 1259 days.

32. Following the reply filed on 03-31-2003, the Examiner initiated a suspension (Rule 103(e)) in a letter dated 06-20-2003.

33. The PTO noted in the Decision that the Office "responded" to applicant's reply of 03-31-03 by suspending the application pending interference review. It is evidently the PTO's

position that the 06-20-2003 suspension letter somehow excused the PTO's delay under Rule 703(a)(2).

34. The PTO's position is incorrect and fails to comply with its own rules on point.

35. The PTO interpreted 35 U.S.C. § 154(b)(1)(A)(ii) via rulemaking. 65 Fed. Reg. 56,366 (Sep. 18, 2000).

36. In particular, 37 C.F.R. § 1.703(a)(2) reads (emphasis added):

“The period of adjustment under §1.702(a) is the sum of the following periods . . . (2) The number of days, if any in the period beginning on the day after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either an **action under 35 U.S.C. 132**, or a notice of allowance under 35 U.S.C. 151, whichever occurs first....

35 U.S.C. § 132 (a) reads (emphasis added):

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such **rejection, or objection or requirement**, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, **the application shall be reexamined....**

37. The suspension letter dated 06-20-2003 is neither a Notice of Allowance nor an action under 35 U.S.C. § 132, as that term is used in 37 C.F.R. § 1.703(a)(2).

38. The PTO cites no authority for its apparent position that a suspension letter is an “action under 35 U.S.C. § 132.”

39. A suspension letter is not a “rejection” as used in § 132(a).

40. A suspension letter is not an “objection” as used in § 132(a).

41. A suspension letter is not a “requirement” as used in § 132(a).

42. The suspension letter of 06-20-2003 indicated that the claims were allowable and never set a time for prosecuting the application under 35 U.S.C. § 133. As such, the delay is

100% attributable to the PTO, because there was nothing that Patentee could have done to persist in getting the application “reexamined.”

43. A suspension of action cannot logically amount to an action under § 132 merely because the Office initiated the suspension. A suspension of action is a delay, and a PTO suspension letter is the PTO’s admission of delay. No provision allows the PTO to excuse its delay by notifying applicant that the PTO will delay.

44. Furthermore, if an applicant is charged with delay for initiating a suspension, 37 C.F.R. § 1.703(c)(1), then there is no reason to excuse the PTO for its delay. Along these lines, the MPEP even recognizes that suspensions at the PTO’s initiative, e.g., under Rule 103(e), may lead (and here should lead) to patent term adjustment. MPEP § 709II.

45. Moreover, following a suspension by the PTO, the rules require nothing of the applicant. In contrast, the MPEP recognizes two exemplary “requirements” under § 132, namely, a restriction requirement and a requirement for information under Rule 105. MPEP § 709IC(1)(E). For these requirements, action by the applicant is required before the PTO continues prosecution.

46. In the present ‘116 application file history, no action was required of the applicant (now Patentee) in response to the letter of suspension dated 06-20-2003. (Notwithstanding the lack of a § 132 “requirement,” Applicant filed at least three separate status inquiries.)

47. The suspension letter dated 06-20-2003 is neither an action under 35 U.S.C. § 132 nor a notice of allowance under 35 U.S.C. § 151. Therefore, the Office’s initial calculation of 1075 positive days, which is the number of days beginning four months after the Applicant’s reply was filed on 03-31-2003, until a Notice of Allowance was issued on 07-10-2006, was correct since this calculation was in accordance with the PTO’s regulations. A PTO reduction of that initial calculation of 1075 positive days is inconsistent with 5 U.S.C. § 706.

48. If the PTO grants both this basis of the reconsideration and the previous basis for reconsideration, a PTA of at least 1,196 days is due. The calculation could be itemized as follows

A. 0 days of PTA under Rule 702(a)(1).

B. 1235 days of PTA under Rule 702(a)(2): this period was determined by the period of delay between the reply filed 02-27-2002 and the PTO's Office action dated 12-02-2002 (160 days) plus the period of delay from the reply filed 03-31-2003 and the notice of allowance dated 07-10-2006 (1075 days).

C. 273 days of PTA under Rule 702(a)(3): this period was determined by the period of delay between the Board Decision dated 07-15-2005 and the Notice of Allowance dated 07-10-2006. This period overlaps with the 1075 day period under Rule 702(a)(2).

D. 24 days of PTA under Rule 702(a)(4): this period was determined by the period of delay between paying the issue fee on 10-10-2006 and issuing the patent on 03-06-2007.

E. The PTO did not determine the period under Rule 702(b).

F. 168 days of PTA under Rule 702(c): this period was determined by the period of delay during the interference declared 04-01-2005 and terminated 09-16-2005. This period overlaps with the 1075 day period under Rule 702(a)(2).

G. (-27 days) of PTA under Rule 704(b): This period was determined by the period of delay between the Office action dated 12-04-2002 and the reply filed 03-31-2003.

H. (-36 days) of PTA under Rule 704(c)(10): this period was determined by the period of delay between the Rule 312 amendment that was received by the PTO 08-08-2006 and the entry of that Rule 312 amendment on 09-12-2006.

I. 1196 days of total PTA: this was determined by summing the periods A+B+D+G+H (i.e., $160+1075+24-27-36=1196$ days) (Periods C and F were not counted due to their overlap with at least one other period. Cf. 37 C.F.R. § 1.703(f) (sum PTO delay "to the extent that such periods are not overlapping"))).

49. This issue could not have been raised in the first request for consideration, because the notice of allowance included the 1075 day period under Rule 702(a)(2). Cf. 37 C.F.R. § 1.705(d).

C. Third Basis for Reconsideration of items Relevant to PTA under 37 C.F.R. § 1.702(b)

50. The PTO failed to consider any adjustments due under Rule 703(b).
51. Under Rule 703(b), the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) is 12-30-2003.
52. Under Rule 703(b), the date that the patent issued is 03-06-2007.
53. 1163 days is the period of the previous two items.
54. Under Rule 703(b)(1), (3), and (4), no adjustments are needed.
55. Under Rule 703(b)(2), the period of the interference is 168 days.
56. 995 days is the total period of adjustment under Rule 702(b) -- that is, $1163 - 168 = 995$.
57. This issue could not have been raised in the first request for reconsideration, because this period would have been excluded from the first determination accompanying the notice of allowance since the issue date was uncertain. *Cf.* 37 C.F.R. § 1.705(d).

III. Conclusion

Correct Patent Term Adjustment: in view of the foregoing, Patentee respectfully requests the PTO to correctly award 1,411 days of PTA. The calculation is shown below:

- A. 0 days of PTA under Rule 702(a)(1).
- B. 1259 ($= 160 + 1075$) days of PTA under Rule 702(a)(2): this period was determined by the sum of the period of delay between the reply filed 02-27-2002 and the Office action of 12-04-2003 (160 days), and the period of delay between the reply of 03-31-2003 and the notice of allowance dated 07-10-2006 (1075 days).
- C. 273 days of PTA under Rule 702(a)(3): this period was determined by the period of delay between the Board Decision dated 07-15-2005 and the notice of allowance dated 07-10-2006. This period overlaps with the 1075 day period under Rule 702(a)(2).
- D. 24 days of PTA under Rule 702(a)(4): this period was determined by the period of delay between paying the issue fee on 10-10-2006 and issuing the patent on 03-06-2007.

E. 995 days of PTA under Rule 702(b): this period was determined by the delay between the third year of pendency 12-29-2003 and the issuing of the '495 patent on 03-06-2007. This period partially overlaps with the 1075 day period under Rule 702(a)(2).

F. 168 days of PTA under Rule 702(c): this period was determined by the period of delay during the interference declared 04-01-2005 and decided 07-15-2005. This period overlaps with the 1075 day period under Rule 702(a)(2).

G. (-27 days) of PTA under Rule 704(b): this period was determined by the period of delay between the Office action dated 12-04-2002 and the reply filed 03-31-2003.

H. (-36 days) of PTA under Rule 704(c)(10): this period was determined by correcting the period of delay attributed to Patentee for filing an amendment under Rule 312.

I. 1,411 days of total PTA: this was determined by summing the periods A+B+C+D+E+F+G+H days "to the extent that such periods are not overlapping" as defined under Rule 703(f), (see Table 1) which effectively amounts to the periods of

160 days from 06-27-2002 to 12-04-2002 (under Rule 702(a)(2))
1314 days from 07-31-2003 to 03-06-2007 (under Rules 702(a)(2),
702(a)(3), 702(a)(4), 702(b), and 702(c))
less (-63 days) admitted delay.

58. The deciding official is invited to contact the undersigned with questions regarding this Request for Reconsideration.

59. The PTO is asked for the just, speedy, and inexpensive disposition of this Request for Reconsideration, including correcting any inadvertent math errors, making adjustments based on either basis for reconsideration should one basis be not granted, and making other just and fair determinations.

The Commissioner is hereby authorized to charge any additional fees which may be required for this Request or regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information

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resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date 05-04-2007

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By

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